

REMARKS

Reconsideration is requested.

The Examiner has stated that the changes made by the Certificate of Correction of July 16, 2002 should be included in the reissue application without underlining or bracketing. Applicants hereby submit those paragraphs with the corrections stated on the Certificate of Correction, without any bracketing or underlining indicating those changes (MPEP 1411.01).

A substitute claims page including a revised claim 2 is submitted herewith.

The Examiner has stated that the 3.73(b) certification and the consent to reissue are not acceptable due to the signatory, Michael Lynch, not being empowered to act on behalf of the Assignee Micron Technology, Inc. In the attachments to the Statement under 37 CFR §3.73(b), a copy of Assignee's Board of Directors' Resolution authorizing Michael Lynch to act on behalf of Micron Technology, Inc., was included. A copy of this Board of Director's Resolution, with the Express Mail No. EV979950225 stamped thereon, is attached hereto. A copy of the Ex Post Declaration of Express Mailing by Express Mail No. EV979950225, also listing the Board of Directors' Resolution as enclosed as part of Item No. 11, is included herewith.

The Examiner has taken the position that claims 20-38 and 44-53 are drawn to a separate invention and attempt to correct an error not within the meaning of the reissue statute. Claims 20-38 and 44-53 have been cancelled. Applicants reserve the right to file a divisional application directed to the cancelled claims. The Office may reissue a patent as multiple reissue patents. If applicant files more than one application for the reissue of a single patent, each such application must contain or be amended to contain in the first sentence of the specification a notice stating that more than one reissue application has been filed and identifying each of the reissue applications by relationship, application number and filing date. The Office may correct by certificate of correction under §1.322 any reissue patent resulting from an application to which this paragraph applies that does not contain the required notice. See 37 C.F.R. §1.177.

The Court in *In re Graff*, 111 F.3d 874, 876-77, 42 USPQ2d 1471, 1473 (Fed. Cir. 1997) stated that, "[t]he statute does not prohibit divisional or continuation reissue applications, and does not place stricter limitations on such applications when they are presented by reissue, provided of course that the statutory requirements specific to reissue applications are met." Following the decision in *Graff*, the Office has adopted a policy of treating continuations and divisionals of reissue applications, to the extent possible, in the same manner as continuations and divisionals of non-reissue applications.

Claim 2 as herein presented contains the corrections as contained in the Certificate of Correction dated July 16, 2002, without any deletions or additions bracketed or underlined (MPEP 1411.01), thereby incorporating all Certificate of Correction changes.

Claim 19 stands rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,960,983 to Inoue.

Claim 19 recites a method of forming a device comprising providing a recess within a substrate; providing at least a portion of an RF antenna within the recess; providing an integrated circuit at least partially within the recess and in operative electrical connection with the antenna; and wherein the antenna crosses itself at a bypass, said bypass comprising dielectric material between crossing portions of the antenna.

Contrary to the Examiner's allegation, the Inoue reference fails to teach or suggest providing a portion of an RF antenna. Instead, Inoue discloses a magnetically inductive coil. Unlike RF communications, communication through magnetic coupling is limited to a fairly short range.

Therefore, claim 19 is allowable.

Claims 39-43 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,566,441 to Marsh et al., in view of U.S. Patent No. 6,514,367 to Leighton.

Claim 39 recites a method of forming a radio frequency identification device comprising forming a recess in a flexible plastic substrate, the recess having a bottom surface and sidewall surfaces that slope outward from the bottom surface toward an upper surface of the substrate; providing an integrated circuit within the recess, the integrated circuit comprising RFID circuitry to provide memory and processing functions; providing at least a portion of an antenna over the upper surface of the substrate; providing a conductive film coupled to the integrated circuit at a first end, extending over at least a portion of one of the sidewall surfaces, and coupled to the portion of the antenna at a second end; and laminating a flexible plastic film over the recess, the integrated circuit, the conductive film, and the antenna.

The Marsh et al. reference fails to teach or suggest laminating a flexible plastic film over the recess, the integrated circuit, the conductive film, and the antenna.

It would not be obvious to combine the Leighton reference with the Marsh et al. reference because there is no teaching in the references which would suggest their combination.

It would not be obvious to substitute a portion of the process of Leighton for portions of the process of Marsh et al. because there is no teaching in the references of how the components should be combined or of which steps of Leighton should be combined with which steps of which of the many embodiments of Marsh et al. There are no teachings in the references themselves which teach that there would be any advantage resulting from selecting portions of the method of Leighton and integrating those steps somehow into the method of Marsh et al. The mere fact that the structures of the references could possibly be somehow modified to result in the claimed structure does not render the claimed structure obvious unless the references themselves suggest the desirability of the modification. See *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Evidence of a suggestion to combine may flow from the prior art references themselves, from the knowledge of one skilled in the art, or from the nature of the problem to be solved. However, this range of sources does not diminish the requirement for actual evidence. Further, the showing must be clear and particular. See *In re Dembiczak*, 175 F.3d 994, 998, 50 USPQ2d 1614, 1616 (Fed. Cir. 1999).

If Leighton were combined with Marsh et al., there would be no need for a recess or indentation.

Further, Marsh et al. teaches away from the combination. Marsh discloses that the substrate may define a container or a closure for a container. In Col. 4, lines 30-33, Marsh et al. teach that the cardboard blank 28 is now fed through the remaining stages of production, including a printing stage, and a cutting and folding stage in which the blank is formed into a cardboard box which can be filled as usual. This is incompatible with the smart card design of Leighton. Further, Marsh et al. teaches that the users of transponders are afforded maximum flexibility if the identification code is programmed in at the time of attaching the transponder to the substrate. See the flowchart of Fig. 18, which summarizes the embodiment of Figs. 18-23 (see Col. 5, lines 54-56). An ID code is programmed after a chip is put into place. In the Leighton process, the electronic element 20 is positioned between first and second sheets of card stock 30, 32, before ram pressure is provided to upper and lower platens. There is no teaching or suggestion of positioning the electronic element on just one of the two sheets, programming the identification code, then applying the second sheet.

Therefore, claim 39 is allowable.

As claims 40-43 depend on claim 39, they too are allowable.

The Examiner's indications at the bottom of page 7 of the Office Action that claims 1, 2, 3, 6, 11, 13, and 18 contain allowable subject matter, not taught

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by the prior art of record, is acknowledged. Allowance of claims 1-18 is requested.

A Statement of Status and Support in accordance with 37 CFR 1.174(c) is attached as a separate paper.

This application is believed to be in immediate condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview prior to issuance of any such subsequent action.

Respectfully submitted,

Dated: March 7, 2005

By: 
Deepak Malhotra
Reg. No. 33,560

Encls.: Copies of previously filed Board of Directors' Resolutions and Ex Post Declaration of Express Mailing; Sheet showing Claim 2 as corrected in Certificate of Correction; Statement of Status and Support.